



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,240	01/21/2004	Kia Silverbrook	WAL10US	2184
24011	7590	06/14/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			FERGUSON, MARISSA L	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,240

Applicant(s)

SILVERBROOK ET AL.

Examiner

Marissa L. Ferguson-Samreth

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3, 4, 11, 12, 14, 17, 18, 20,22,33,39,40-43,46,47,49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Martin (US Publication 2002/0171692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0118990).

Regarding claims 1, 3, 4, 11, 22, 33,39, 40-43, 47, 49 and 51, Martin teaches an on-demand printer (18) comprising a cabinet/frame (housing of printer 18 and refer to figure on page 4) in which is located a media path (look at figure on page 5) which extends from a media (27) loading area to a printhead (20) and from the printhead to a dispensing slot (refer to figure on page 4), the printer having one or more printer input devices (36,37) which communicate with a processor (38 and paragraph 0009) to capture data regarding one or more customer requirements including changing a pattern (paragraph 0010) , the data comprising at least a customer selected pattern (paragraph 0010, Lines 7-11), providing the franchisee with a collection of patterns in a digital storage medium (30) that can be read by the printer, enabling the franchisee to

print a roll of wallpaper, onto a web of blank media, on demand, according to the selected pattern (Abstract), winding area (26 and refer to figure on page 5 of office action) adapted to removably retain a core (core can be removed by reversing the process) and wind onto it, wallpaper produced by paper. With regards to obtaining a fee the consumer transaction is considered to be implicitly anticipated because it is known to exchange a fee for a product.

However, Martin does not teach a printer that allows the customer to select a width and a printer that is used to longitudinally slit a web into two longitudinal portions, the first portion having the customer selected width and the second longitudinal portion being the waste remainder. Fujii et al. teaches calculating an amount of wallpaper required by the customer based on room dimensions such as width supplied by customers (Figures 6,7 and 9). However, he does not disclose longitudinally cutting/slitting the web wherein the first portion has the customer selected width and the second longitudinal portion being the waste remainder. Kwasny teaches a slitting/cutting mechanism (16) for longitudinally slicing the web (Figure 2). With regards to the first portion having the customer selected width and the second longitudinal portion being the waste remainder, the examiner notes that the limitation is intended use and does not positively recite any further limitations in the claim.

It would have been obvious to one of ordinary skill to modify the invention of Martin to include the width of wallpaper as per the customers requirements as taught by Fujii et al., since Fujii et al. teaches that it is advantageous to properly and accurately print out the wallpaper based on customer requirements.

Art Unit: 2854

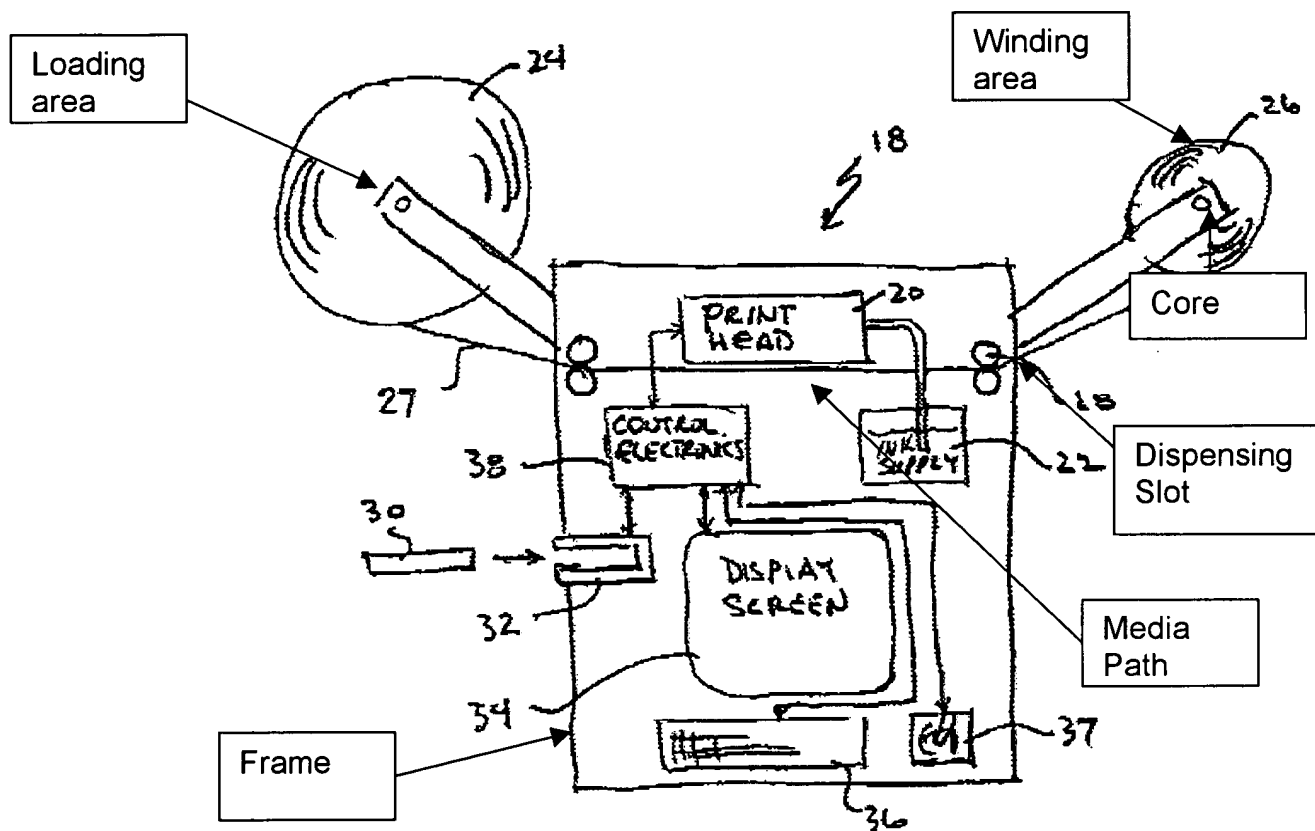
It would have been obvious to one of ordinary skill in the art to modify the invention of Martin to include a slitting/cutting mechanism as taught by Kwasny, since Kwasny improves the efficiency of cutting a web into multiple narrow sheets.

Regarding claims 12 and 14, Martin teaches providing media canister (24) to contain unprinted web and loading the canister with blank media (inherent to load the canister on the printer).

Regarding claims 17 and 18, Martin teaches a printhead (20) that is a full width color printhead that prints patterns accessible to the processor (38) and using a full width printhead (20) to print onto the web while it is motion (it is inherent that the printer is in motion).

Regarding claim 20, Martin teaches a franchisee that is instructed to operate the printer for a customer (Abstract and paragraph 001 1).

Regarding claim 46, Martin teaches a printhead (20) being supplied with inks from ink supply (22) which is remote from the printhead and which is supplied through tubing (Figure 2).



Martin, Fujii et al. and Kwasny all teach the claimed method including a display screen (paragraph 0058), however he does not teach a printer that acquires data from a touch-screen display which is also adapted to display the pattern to a customer of the

Art Unit: 2854

franchisee. Goldstein teaches a step of using a touch-screen that operates with a wallpaper creation program (Abstract, element 102 and paragraph 0058, lines 22-27). It would have been obvious to one of ordinary skill to further modify the invention of Martin to replace the display screen thereof with the touch-screen display of Goldstein, since Goldstein teaches that it is advantageous to provide an easy and quicker method of entering data.

3. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Gerber et al. (WO 03/064170).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of an input device such as a scanner for capturing data. Gerber et al. teaches a method of printing wallpaper including an input device such as a scanner (24) for scanning designs and patterns that are used in wallpaper design (page 3, lines 18-20 and lines, 31-33). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a scanner as taught by Gerber et al., since Gerber et al. teaches that it is advantageous for easily inputting designs that are selected by the operator.

4. Claims 7,8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claims 1 and 4 above, and further in view of Krinsky (US Patent 6,354,212).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of providing a variety of blank media types so that they may be used in the printer, providing one or more collections of printed swatches, which correspond to patterns that the printer is able to print on demand and providing new patterns from time to time. Krinsky teaches a method of preparing customized wallpaper panels (1-4 and 3-6) that are used in the printer, a collection of samples (Column 4, Lines 11-15) and the customers have the ability to personalize or customize their own designs (Column 2, Lines 38-67 and Column 3, Lines 1-22). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a plurality of blank media types and a collection of samples as taught by Krinsky, since Krinsky teaches that it is advantageous to provide personalized custom wallpaper panels for aesthetically pleasing purposes.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of in view of Fujii et al. (US Patent 6,715,423), Kwasny (US Publication 2002/01189900) and Krinsky (US Patent 6,354,212) as applied to claims 1 and 8 above, further in view of Lapointe et al. (US 5,056,142).

Martin, Fujii et al., Kwasny and Krinsky all teach the invention claimed with the exception of swatches that are assigned a printed symbol. Lapointe et al. teaches a device that has a sample book of samples that each contain symbols (Column 1, Lines 53-60 and column 4, Lines 59-68). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a samples that contain symbols as taught by Lapointe et al., since Lapointe et al. provides a easier method of identifying a particular sample in a quick, efficient amount of time.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0189900) as applied to claims 1 and 12 above, and further in view Schoendienst et al. (US Patent 5,302,037).

Martin, Fujii et al., and Kwasny all teach the claimed method with the exception of providing a motor in the printer to advance the unprinted web into the path by automatically threading the media through the printer. Schoendienst et al. teaches using a motor (M) for advancing a web and it should be obvious that the web will automatically thread. It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a motor that automatically threads a web as taught by Schoendienst et al., since Schoendienst et al. teaches that it advantageous to provide the necessary power to accurately advance the web.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423), Kwasny (US Publication 2002/0189900) as applied to claim 1 above, and further in view of Bilek (US Patent 4,322,044).

Martin, Fujii et al. and Kwasny all teach the claimed method including loading a disposable media tote (26) into a winding area adjacent to the dispensing slot and winding a printed roll of wallpaper onto a core inside the tote (refer to figure below), however he does not explicitly disclose severing the printed roll on the core from the web. Bilek teaches a printer with a take-up roll core (39) and a paper tear bar (34) for severing the print media web (19) from the supply roll (17 and column 3, Lines 21-22).

It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a tear bar for severing as taught by Bilek, since Bilek teaches that it is advantageous to easily separate the media web from the supply roll.

8. Claims 19,38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Sandhoo (DE 29908649).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of drying a web after it is printed on but before it is dispensed by the printer. Sandhoo teaches a dryer (no element number is provided) located between the printing area (4) and the winding area (6) for drying the printed web (8). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a dryer as taught by Sandhoo, since Sandhoo provides a dryer for quickly and efficiently drying a printed web to prevent smudging.

9. Claims 21, 35,45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Harris et al. (US Patent 5, 161,685).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of a tote for holding cores which cooperate with a winding area and a disposable exterior in which is formed a main access flap and a pair of core access openings and the tote having an interior in which is located a disposable core which is aligned with the access

openings and exposing a molded coupling, attached to each end core, at least one core of the couplings being a driven coupling and adapted to engage a driving spindle that rotates a core .

Harris et al. teaches a tote for holding a core with a winding area including a disposable exterior (42 and also note that Taylor et al. is silent of a material of exterior that is disposable, however anything can be considered disposable) with a main access flap (46) and a pair of core access openings (44b,46b) that are comprised with bearing surfaces (column 5, lines 13-19) and the tote having an interior in which is located a disposable core (any object can be disposable), which is aligned with the access openings (Figure 5), has molded hubs (48) for supporting the core, c and an external coupling (50) that could be used to engage a rotating winding spindle.

It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a tote as taught by Taylor et al. for the purpose of providing an easy method of transporting, protecting and dispensing a roll of media.

10. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900).

Martin, Fujii et al. and Kwasny all teach the claimed method including using a printhead (20), however the prior art does not explicitly a wide selection of desire rates at which a printhead prints on a web/medium or the selection of the number of nozzles or number of ink drops for each of the printheads. However, it has been held that through routine experimentation that it would be obvious to test a wide selection of

printheads since such an experimentation would result in acquiring the best possible print quality.

11. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0189900) as applied to claim 1 above, and further in view of Nagel (US Patent 5,362,008).

Martin, Fujii et al. and Kwasny all teach the claimed invention with the exception of a case having two halves, hinged together, an area between the two halves, when closed defining a media slot and the case having internally and adjacent slot, a pair of rollers, at least one roller being a driven roller, which is supported at each end, by the case. Nagel teaches a media cartridge including a case with two halves (20a,21 and Figure 5), a media supply slot (23) located between the two halves when they are closed, a pair of rollers (39,40) inside the case and adjacent the supply slot (23) and a driven roller (40) that can be driven by an external motor (Figure 5). It would have been obvious to one of ordinary skill to further modify the invention of Martin to replace the case thereof with a hinged case as taught by Nagel, since Nagel teaches that it is advantageous to provide a case that is easy to open.

12. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0189900) as applied to claim 1 above, and further in view of Nielson et al. (US Patent 4,885,964).

Martin, Fujii et al. and Kwasny all teach the claimed invention with the exception of a chassis having end plates, slitter shafts and slitting mechanism. Nielson et al. discloses a slitting mechanism including a chassis having end plates and transverse portion (shown in Figure 1), a slitting shaft (12) having a plurality of slitters (13) with cutting edges (Figure 2). It would have been obvious to one of ordinary skill to further modify the invention of Martin to replace the case thereof with a chassis with end plates and a slitting mechanism for providing a stable mechanism for effectively cutting a web.

13. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0189900) as applied to claim 1 above, and further in view of Schoendienst et al. (US Patent 5,302,037) and Yada (JP 2003/063700).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of providing a motor in the printer to advance the unprinted web into the path by automatically threading the media through the printer and pilot guide. Schoendienst et al. teaches using a motor (M) for advancing a web and it should be obvious that the web will automatically thread. However, Schoendienst et al. does not teach a pilot guide. Yada teaches a pilot guide (4220) for print media (100b, Figure 15). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a motor that automatically threads a web as taught by Schoendienst et al., since Schoendienst et al. teaches that it advantageous to provide the necessary power to accurately advance the web and to include a pilot guide for guiding the print media in a desired direction so that it does not jam and disrupt the printing process.

Response to Arguments

14. Applicant's arguments filed 5/26/06 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Martin teaches wallpaper borders and Fujii et al. teaches a method of manufacturing wallpaper and a program that functions as a wallpaper apparatus. It would be assumed that since both prior arts are within the art of wallpaper that one of ordinary skill in the art would recognize that the two apparatuses could be combined. The examiner also notes that Fujii et al. teaches a more complicated process, however the same results are obtainable with the apparatus.

Kwasny et al. teaches cutting/slitting a medium. The examiner notes that the wallpaper would be considered a medium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson whose telephone number is (571)

Art Unit: 2854

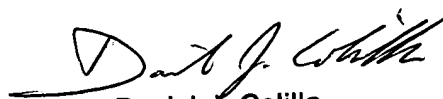
272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson-Samreth
Examiner
Art Unit 2854

MFS


Daniel J. Colilla
Primary Examiner
Art Unit 2854